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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,289	10/22/2001	Michael Roy Coke II	014208.1434	5060
5073	7590	06/07/2005	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			LEVINE, ADAM L	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/010,289	<b>Applicant(s)</b> COKE ET AL.	
	<b>Examiner</b> Adam Levine	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20 November 2002</u> . | 6) <input type="checkbox"/> Other: _____  |

*ASD*

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed January 31, 2002, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

2. The drawings were received on February 26, 2002. These drawings are objected to by the Examiner. The drawings are objected to because solid black shading is not permitted. Figure 4 is unreadable. 37 CFR 1.84 (m). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each

drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 31-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Moreover, the courts have found that a claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer. See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). Finally, the Board of Patent Appeals and Interferences (BPAI) has recently affirmed a §101 rejection finding the claimed invention to be non-statutory based on a lack of technology. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case the mere recitation of the word "online," thus implying the use of indefinite technological machinery, does not confer statutory subject matter where there is no recitation in the claims sufficient to breathe technology into the term.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case the use of technology is at best trivial. At worst it merely permits the use of online communication.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 1-4, 6-12, 14-19, 21-27, and 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Geller (US Pat. No. 5,844,554).**

Geller teaches all the limitations of Claims 1-4, 6-12, 14-19, and 21-27. For example, Geller discloses downloading from a server an interface for communication with said server (see at least column 8 lines 39-50, Fig. 2). Geller further discloses:

- allowing a customer to choose one or more features from a predetermined set of features relating to the product (see at least column 16 lines 50-61, Fig. 6).
- downloading from the server one or more software components relating to each chosen feature (see at least column 2 lines 20-36, column 10 lines 29 - column 11 line 11, column 14 lines 30-42)

- allowing the customer to modify at least one of said chosen features of the product by use of the related software component: modify at least one attribute of one or more chosen features, wherein said attribute(s) relate to shape, three-dimensional location and appearance (see at least column 17 lines 10-29, Figs. 6, 7).
- presenting to the customer for viewing a simulation of the product incorporating said at least one feature modification: wherein said simulation is available to the server for evaluation (see at least column 10 lines 13-28).
- recording feature modification on the server: (see at least column 9 lines 6-22, Figs. 1-7, column 14 lines 30-42).
- collecting pre-determined user data from the user: recording said user data on the server (see at least column 2 lines 37-56, column 14 lines 30-42).
- relating said recorded at least one feature modification to said recorded user data for evaluation: (see at least column 2 line 66 – column 3 line 9).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 5, 13, 20, 28, and 33-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geller (US Pat. No. 5,844,554) in view of Abelow (US Pat. No. 5,999,908).**

Geller teaches all of the above as noted under the 102(b) rejection and teaches a) generating a user product configuration program module, b) controls allowing user to input information for use in configuration computations, c) evaluation of user input by a server in the configuration of a product, d) the generation of a purchase order and bill of materials for manufacture of the configured product, and further teaches the easy creation of a custom user interface tailored to specific needs, updateable via a server to accommodate new product information and choices, and responsive to constraints chosen by the user. Geller however does not disclose user data relating to the user's demographics. Abelow teaches user data relating to the user's demographics for the purpose of matching demographics to user product design preferences in the development and design of products (see at least column 26 lines 7-48, column 37 lines 22-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the systems and methods of Geller to include user data related to user's demographics in order to make vendors faster, more efficient, and more responsive in designing and delivering what customers want to buy, thereby attracting greater sales.

Geller teaches all of the above as noted under the 102(b) rejection and teaches a) allowing consumers to access a product model, b) allowing consumers to modify at least one feature to express design preferences, c) gathering data and making it available to a designer, and d) evaluation of user input in the configuration of a product. Geller however does not disclose statistically organizing gathered data based on pre-determined parameters to discern customer preference, scientifically integrating said



data in product design process, and using said data to alter a product design based on preference, use of said data by a designer for end-stream customer-specific design modifications, mid-stream modifications of in-progress design, or to obtain initial user-specific design, use of said data by a vendor to perform real-time modifications in a marketing process, use of said data by a manufacturer to replace current design with design incorporating features based on data collected, or to perform real-time changes in a product manufacturing process. Abelow teaches statistically organizing gathered data based on pre-determined parameters to discern customer preference, scientifically integrating said data in product design process, and using said data to alter a product design based on preference, use of said data by a designer for end-stream customer-specific design modifications, mid-stream modifications of in-progress design, or to obtain initial user-specific design, use of said data by a vendor to perform real-time modifications in a marketing process, use of said data by a manufacturer to replace current design with design incorporating features based on data collected, or to perform real-time changes in a product manufacturing process (see at least abstract, Figs. 1, 2, 13-15, 25, 33, column 1 line 56- column 2 line 36, column 8 lines 15-32, column 12 lines 20-54). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and systems of Geller to include statistically organizing gathered data based on pre-determined parameters to discern customer preference, scientifically integrating said data in product design process, and using said data to alter a product design based on preference, use of said data by a designer for end-stream customer-specific design modifications, mid-stream modifications of in-

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progress design, or to obtain initial user-specific design, use of said data by a vendor to perform real-time modifications in a marketing process, use of said data by a manufacturer to replace current design with design incorporating features based on data collected, or to perform real-time changes in a product manufacturing process in order to make vendors faster, more efficient, and more responsive in designing and delivering what customers want to buy, interacting with them during the purchase process and in keeping them happy with what they have already bought, thereby attracting greater sales.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Teresko, John; Sheridan, John; Stevens, Tim; Taninecz, George. 25 winning technologies (IW's 4th Annual Technology & Innovation Awards), Dec. 16, 1996; Industry Week, v245, n23, p.14(22) (see at least pages 2, 5-6, and 8). Describes several systems and methods for improving accessibility of computer assisted design, including online accessibility.
- Dilger, Karen Abramic; Design by Desire (Manufacturers use configuration systems to speed the order process, reduce inaccuracies; the system can also be used to enhance customer service), March 1998; Manufacturing Systems, v16, n3, p. 62-73.

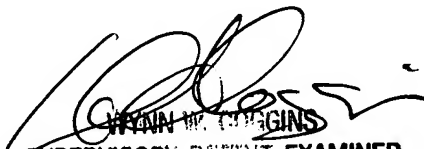
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571.272.7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine  
Patent Examiner  
May 31, 2005



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